

Application No.: 10/004847

Case No.: 57320US002

**Remarks**

Claims 1 to 17 are pending. No claims have been canceled. No claims have been withdrawn from consideration. Claims 2, 11 and 14 are amended. No claims have been added.

**Claim Objections**

Claims 14 and 15 are objected to under 37 USC 1.75(c) as being improperly dependent.

Claim 14 is amended herein to correct the dependency to claim 13 as properly noted by the Examiner. Applicants regret the error.

Claim 2, and claims dependent thereon, are objected to because it is (as asserted) not apparent whether the further reaction product is the reaction product of claim 1 or whether the composition contains and additional reaction product of a monofunctional compound.

Applicants believe that the original claim is clear, and the specification provides further clear indication that the aliphatic monofunctional compound of claim 2 reacts with the isocyanate groups of the polyisocyanate. This is further clarified by dependent claims 3, 4, 6 and 7. However in an effort to advance prosecution, claim 2 has been amended to expressly state that the monofunctional compound reacts with the polyisocyanate.

Claim 11 has been amended as suggest by the Examiner.

**Obviousness-type Double Patenting**

Claims 1-11, 13, 14, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-9, 11-14 19 and 24-26 of copending Application no 10/124,523 in view of Smith et al. (U.S. 5,350,795).

In response, enclosed is a "Terminal Disclaimer Under 37 C.F.R. Section 1.321(b)," which disclaims the portion of the term of any patent granted on the instant application that would extend beyond the expiration date of the term of copending Application no 10/124,523. The Disclaimer also indicates that the instant application, and the copending Application no 10/124,523, are commonly owned by 3M Innovative Properties Company by virtue of assignments recorded at reel/frame 012361/0128 on 12/04/2001 (for the instant application) and at reel/frame 012743/0702 on 05/29/2002 (for copending Application no 10/124,523). The

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Disclaimer further indicates that the chain of title of the instant application has been examined in order to comply with 37 C.F.R. Section 3.73(b).

Since under 37 C.F.R. Section 1.78(d) a terminal disclaimer in compliance with 37 C.F.R. Section 1.321(b) can be used to overcome a non-statutory double patenting rejection, Applicants respectfully request that the double patenting rejection be withdrawn.

The rejection of claims 1-11, 13, 14, 16 and 17 under the judicially-created doctrine of obviousness-type double patenting over claims 1-5, 7-9, 11-14 19 and 24-26 of co-pending Application no 10/124,523 in view of Smith et al. (U.S. 5,350,795) has been overcome and should be withdrawn.

### § 102 Rejections

Claims 1-5, 9 and 11-16 stand rejected under 35 USC § 102(e) as being anticipated by Application no 09/803,702 (Qiu et al., U.S. 2003/0026997). The rejection is traversed.

Qui et al. neither anticipates nor suggests the claimed invention. The reference describes an oligomeric fluorochemical urethane composition, which is the reaction product of:

- 1) one of more fluorinated polyols;
- 2) one of more polyisocyanates; and
- 3) one or more monofunctional fluorine-containing compounds.

While the instant claims and the reference have similar elements in common, specifically elements 2 and 3, *supra*, the elements are not identical. In making the rejection, the Office Action ignores a critical and necessary element of the reference: the fluorinated polyols. The fluorinated polyols of Qui et al. are described at length in paragraphs 77 to 85 on pages 5 and 6 of the reference. Applicant's claimed composition contains no such reactive species.

As evidence of the essential nature of the reference fluorinated polyols, the Examiner's attention is directed to reference Table 1, page 19. Comparative Examples C1 and C2 contain pendent fluoroalkyl groups derived from a fluorinated polyols, but no terminal fluoroalkyl groups. Comparative Example C3 contains terminal fluoroalkyl groups, but no pendant fluoroalkyl groups derived from a fluorinated polyol.

As can be seen from the data, the contact angles for Comparative Examples C1 to C3 are inferior to those of the reference Examples, and C3, lacking a fluoroalkyl group derived from a

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fluorinated polyol, is inferior to even C1 and C2. Thus one skilled in the art, in possession of the teaching of Qui et al., would not be motivated to ignore the fluorinated polyol, as has been done in support of the rejection.

With regard to claims 2 to 4, the Office Action states "Qui teaches the presence of a fluorochemical monofunctional compound that can be additionally reacted." In support of the rejection, the Office Action indicates reference paragraphs 92 to 95.

Although the cited text may be relevant to claim element 1, part b, the cited text is not relevant to claims 2 to 4, which claim an *aliphatic* monofunctional compound, not a *fluorinated* compound. Applicants have described the aliphatic monofunctional compounds on page 12, line 2 to page 13, line 13. Qui et al. neither teach nor suggest the use of such aliphatic monofunctional compounds.

The rejection of claims 1-5, 9 and 11-16 under 35 USC § 102(e) as being anticipated by Application no 09/803,702 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested. Allowance of claims 1 to 17, as amended, at an early date is solicited.

Respectfully submitted,

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Date

By:

Kent S. Kokko  
Kent S. Kokko, Reg. No.: 33,931  
Telephone No.: (651) 733-3597

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833